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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/274,281

03/22/1999

JAY S. WALKER

WD2-99-006

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10/31/2006

WALKER DIGITAL
2 HIGH RIDGE PARK
STAMFORD, CT 06905

EXAMINER

RIMELL, SAMUEL G

ART UNIT

PAPER NUMBER

2164

DATE MAILED: 10/31/2006

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED

OCT 31 2006

Application Number: 09/274,281
Filing Date: March 22, 1999
Appellant(s): WALKER ET AL.

Technology Center 2100

Michael Downs
For Appellant

EXAMINER'S ANSWER

This Examiner's Answer is in response to the appeal brief filed August 11, 2006,
appealing the non-final rejection of July 27, 2005, and re-instating the appeal.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The Grounds of Rejection are herewith re-stated, since Examiner has withdrawn certain rejections. The following are the grounds of rejection on appeal:

- Claims 13-25, 30 and 38 are rejected under 35 USC 112, second paragraph.
- Claims 41, 42, 43, 52, 53, 55 and 56 are rejected under 35 USC 102(e) as being anticipated by Barnett et al. (U.S. Patent 6,336,099).
- Claim 38 is rejected under 35 USC 103(a) as being unpatentable over Barnett et al. in view of Official Notice.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

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- U.S. Patent 6,336,099 to Barnett et al., published January 1, 2002, priority to April 19, 1995.

- Examiner's taking of Official Notice that it was well known in the art to correct a charge to a charge card when such charge was found to be incorrect.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13-25, 30 and 38 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13: It is not clear if a relationship exists or does not exist between the "first amount of funds" and "second amount of funds", making the claim ambiguous.

Claim 38: The last three steps of claim 38 calls for the charging of two different prices to a consumer account based upon a single transaction, making the claim unclear.

Claims 13-30 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

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subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 41, 42, 43, 52, 53, 55 and 56 are rejected under 35 U.S.C. 102(e) as being anticipated by Barnett et al. (U.S. Patent 6,336,099).

Claim 41: FIG. 1 of Barnett et al. discloses the steps of transmitting an indication of at least one item that a customer intends to purchase, which is the step of transmitting user feedback data from the online service provider (2) or a retailer (10) to a coupon distributor (16); (col. 6, lines 58-62). In response to this transmitted indication, the online service provider (2) receives indication of offers for subsidies, which are packages of coupons sent to the online service provider. The subsidies (coupons) are then provided to the customer, with the coupons being provided to the customer before a purchase is made with the coupons. The customer then accepts the offer by using the coupon in a retail store. The coupon acceptance is then transmitted to a coupon redemption database (13). The customer is charged a discounted price based upon the usage of the coupon at a retailer. As seen in FIG. 1, the coupon issuer then issues a discount reimbursement back to the retailer that redeemed the coupon.

Claim 42: The amount of funds reimbursed is based upon the usage of the coupon for a discount. It is illustrated in FIG. 1 as "discount reimbursement".

Claim 43: See remarks for claims 41 and 42. The discount reimbursement is an amount of funds from a party other than the customer.

Claim 52: See remarks for claim 41. A customer may reject an offer for subsidy (coupon) by deleting a coupon (col. 9, line 61) and instead accept the offers provided by other coupons.

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Claim 53: See remarks for claim 41. Col. 7, lines 36-55 further describes an additional step in which the coupon redemption pattern by the consumer is analyzed, in order to decide which coupon offers are most appropriate for directing to the consumer in future coupon downloads. This reads as a ranking of the coupons, and the customer is provided only those coupons which are ranked as being most appropriate for that customer.

Claim 55: See remarks for claim 41. FIG. 1 further illustrates the transmission of "user redemption information" from the coupon redemption database (12) to the coupon distributor (16). This is described in greater detail at col. 7, line 41-55. The user redemption information reads as a historical acceptance rate, and dictates the selection of the coupons sent to the user.

Claim 56: See remarks for claim 41. Col. 13, lines 30-42 describe an additional step in which coupons with lower discounts are sent to known users of a brand, while coupons of a higher discount are sent to known users of a competitors brand. Since a lower discount translates into a higher profit, this reads on the step of selecting specific coupon offers based on their profitability.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barnett et al. in view of Official Notice.

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Claim 38: See remarks for claim 41. Barnett et al. differs from claim 38 in that it does not disclose the steps of charging a consumer a total non-discounted price to a credit card and then correcting this action by charging a corrected discounted price to a credit card.

However, Examiner takes Official Notice that it is well known in the art to correct a charge to a credit card when such a charge is found to be incorrect by a consumer. Typically, a consumer notifies the retailer of the discovery of the incorrect charge and the retailer electronically processes a credit to the consumer's credit card so that the correct amount is ultimately charged for a purchase. Alternatively, the retailer might credit back the entire purchase price and then re-process a new charge to the consumer which accurately reflects the purchase price.

It would have been obvious to one of ordinary skill in the art to modify Barnett et al. to allow retailers to apply credits to a consumer's credit card in order to provide for the correction of incorrect charges to a credit card to reduce or eliminate disputes, as is well known in the art.

(10) Response to Argument

Section 1 of Appellant's Brief: The rejections under 35 USC 101 are vacated in view of *Ex Parte Lundgren*. Accordingly, the issues of this section are moot.

Sections 2.1 through 2.2 of Appellant's Brief: Appellant argues that the rejection being made involves a requirement by the PTO that the exact technique for calculating the "second amount of funds" be elaborated in the claims. This assumption is incorrect, and the appealed office action recites no such basis for the rejection.

Claim 13 has been rejected because it is not clear whether relationship exists or does not exist between the first amount of funds and second amount of funds in claim 13. This ambiguity

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arises because the specification does require a relationship, but the claims do not indicate whether the relationship exists or not. Within appellant's specification, the second amount of funds are derived directly from the first amount of funds (page 22, lines 1-10 of appellant's specification). However, the claims are silent as to whether this relationship exists, making the claims ambiguous as to whether or not the relationship is required when they are read in light of the specification.

MPEP 2173.03 addresses this directly, and instructs the application of a rejection under 35 USC 112 when the inconsistency exists between the claims and specification. MPEP 2173.03 states:

- “Although the terms of a claim may appear to be definite, inconsistency with the specification disclosure or prior art teachings may make an otherwise definite claim take on an unreasonable degree of uncertainty (emphasis added). *In re Cohn*, 438 F.2d 989, 169 USPQ 95 (CCPA 1971); *In re Hammack*, 427 F.2d 1378, 166 USPQ 204 (CCPA 1970).”
- “Noting that no claim may be read apart from and independent of the supporting disclosure on which it is based, the court found that the description, definitions and examples set forth in the specification relating to the appearance of the surface after treatment were inherently inconsistent and rendered the claim indefinite (emphasis added).”

Additionally, appellant adds arguments at page 21 of the brief that only add to the pre-existing ambiguity. Appellant argues at the sixth paragraph of page 12 that claim 13 does not contain any limitations that “preclude” the existence of a relationship, suggesting that the claim

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does define the relationship. However, the claims themselves do not “include” any requirement for the relationship, again making it unclear as to whether the relationship is part of the claim or not.

Examiner maintains that the recited language of claim 13 is ambiguous when read in light of the specification, and thus maintains the rejection under 35 USC 112, second paragraph.

Section 2.3: The rejection of claims 27-29 have been vacated.

Section 2.4: Claim 38 has been rejected under 35 USC 112, second paragraph. Appellant argues that the USPTO is requiring that the claim recite the exact technique as to how the second price is calculated. Again, this is not the basis of rejection cited in the office action, making such argument moot.

Claim 38 was rejected under 35 USC 112, second paragraph for the apparent inconsistency of charging a customer two different prices for the same transaction. In particular, claim 38 calls for charging a customer a “second price” and then a “total price”. It is not clear whether the claim is calling for the customer to be “double billed” for the same item, or charging the user a certain price, followed by a credit, resulting in a lower “net total price” being charged. The claim does not recite that any crediting occurs, so the claim at first appears to be addressed to “double billing”. However, the specification at page 18, lines 10-15 states that the “net total price” process actually occurs instead. Again, the claim creates ambiguity because it is inconsistent with the recited steps in the disclosure, raising the issue of ambiguity under 35 USC 112, second paragraph.

Sections 3.1-3.3: This portion of appellant’s brief deals with the rejection of claims 41, 42, 43, 52, 53, 55 and 56 under 35 USC 102(e). The statements in these sections appear to be

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nothing more than quotations that are not correlated in any way to the prior art, the claims, the rejections or the interpretation of the art.

Section 3.3.1: Appellant alleges that Barnett does not teach: “*receiving in response to the to the transmitted indication of the at least one item, an indication of an offer for a subsidy from a vendor*”. This feature appears in the second paragraph of claims 41, 43, 52, 53, 55 and 56.

Appellant first argues at page 20, fourth paragraph that it is unclear what in Barnett corresponds to the indication of an item that a customer is to purchase. This argument is incorrect, as the office action explicitly identifies this feature at the very outset of the discussion for claim 41. The user/feedback data is illustrated by the left pointing arrow between the on-line service provider (2) and coupon distributor (16). The content of this information is described at col. 6, lines 58-62, where reference is made to a demographic data file that includes coupons selected data, coupons deleted data and coupons printed data that are transmitted to the coupon distributor (16). The user selection of coupons, deletion of coupons or printing of coupons are each indications of items a customer will purchase or desires to purchase. It is clear in Barnett that these selections are indications of desired purchases, because the system of Barnett tracks the redemption of the coupons at the retailer to determine the effectiveness of the incentive. This redemption data is also transmitted to the coupon distributor and serves as a second additional transmitted indication.

Secondly, appellant argues at page 30 in the brief, second to last paragraph, that Barnett et al. does not receive anything at all in response to the transmitted indication. This argument is also incorrect. FIG. 1 of Barnett et al. clearly illustrates the transmission of offers for subsidies by transmitting coupons between the coupon distributor (16) and the on-line service provider (2).

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This is illustrated by the right pointing arrow between (16) and (2) and was explicitly discussed in the office action.

Thirdly, appellant argues in the last paragraph of page 30 in the brief that it is not clear when the coupon data is received. Notwithstanding appellant's contradiction of denying that the online service provider receives anything, and then admitting that it receives coupons, this argument is incorrect. Col. 6, lines 63-65 indicates that coupons are mailed subsequently after the receipt of user data. The coupons themselves are provided prior to a given purchase using that coupon, since a user cannot logically use a coupon they have not previously obtained.

Section 3.3.2: Appellant argues that Barnett et al. does not disclose acceptance of an offer, and incorrectly alleges that this feature is not discussed in the office action. However, the office action discusses this feature in the discussion of claim 41, where it states : "The customer accepts the offer by using the coupon in a retail store" (emphasis added).

Section 3.3.3: Appellant argues that Barnett et al. does not disclose charging a customer a second price which is less than a total price. Again, this was addressed in the office action in the discussion associated with claim 41, where it states: "The customer is charged a discounted price based upon the usage of a coupon at a retailer." In Barnett et al, the coupon is used for a discount because the discount cost is reimbursed back to the retailer by the coupon provider.

For all the above reasons, the rejection of claims 41, 42, 43, 52, 53, 55 and 56 under 35 USC 102(e) should be sustained.

Sections 4.1 through 4.2.4: Appellant's statements here are addressed to the rejection of claim 38 under 35 USC 103(a), invoking Barnett et al. and Official Notice. Appellant's statements are nothing more than generic recitations of the doctrines associated with the taking

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of Official Notice. Appellant's statements make no consideration whatsoever of the actual content of the Official Notice, or how this assertion pertains to Barnett et al.

Examiner has taken Official Notice that it is well known in the art to correct a charge to a credit card when such charge is found to be incorrect by a consumer. For example, correction can take the form of applying a credit, or crediting back the wrong amount and applying the correct amount. Appellant's brief states that no documentary evidence was provided in support of this conclusion, although appellant does not assert that the actual conclusion is incorrect. Rather, appellant only seeks documentary evidence.

The taking of Official Notice was first made in office action immediately previous to the appellant's brief, so the brief constitutes the first time that documentary evidence is being requested. However, Examiner finds that the subject matter for which Notice was taken is of such notoriously well known content and can be so readily demonstrated that it is not unreasonable to take Official Notice. MPEP 2144.03(a). For example, one need only consider the Fair Credit Billing Act (15 U.S.C. 1601) signed into law on July 9, 1986, which outlines procedures by which customers may resolve disputed credit card charges, hundreds of state and local regulations pertaining to credit card dispute resolution dating back to at least 1975, or even conventional credit card statements themselves. Examiner maintains that the subject matter of Official Notice can be readily demonstrated and is well known subject matter since at least 1975, when the earliest regulations were enacted for credit card dispute resolution.

Appellant also argues for lack of motivation to combine. In other words, appellant is taking the position that there is no motivation to permit consumers to correct credit card statements. This assertion is erroneous on its face, as it is clear that having such an ability

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prevents disputes, and has been motivated by public demand resulting in Federal Statutes to permit the practice. The rejection of claim 38 under 35 USC 103(a) is sustained.


For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Conferees:


SAM RIMELL
PRIMARY EXAMINER


CHARLES RONES
SUPERVISORY PATENT EXAMINER


HOSAIN ALAM
SUPERVISORY PATENT EXAMINER

APPEAL CONFERENCE HELD 10/24/06
AGREEMENT TO PROCEED TO APPEAL